

REMARKS

Summary of the Office Action

In the Office Action, claims 1-5 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention

Claims 1-3 and 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,209,772 to *Wang*.

Claims 1 and 3-4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,651,491 to *Heaton, et al.*, hereinafter ("*Heaton*").

Summary of the Response to the Office Action

Applicants propose amending claims 1-5 and adding new claims 6-7. Accordingly, claims 1-7 are pending for further consideration.

All Subject Matter Complies with 35 U.S.C. § 112, second paragraph

Applicants have amended claims 1-5 in order to expedite the prosecution of this case. Applicants respectfully submit that the amendments to claims 1-5 do not narrow the intended scope of the claims, and therefore, Applicants do not intend to relinquish any subject matter by these amendments. Applicants respectfully submit that claims 1-5 meet all the requirements of 35 U.S.C. § 112, as amended. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 112, second paragraph, be withdrawn.

All Subject Matter Complies with 35 U.S.C. § 102(b)

Claims 1-3 and 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Wang*. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that *Wang* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that newly amended independent claims 1 and 3 recite the features of "a guide member with substantially parallel lateral sides for supporting an inner surface of the base portion of the staple legs during a process that the staple legs of the staple are penetrating the sheets." At least this feature is not disclosed or taught by *Wang*.

Wang discloses a manual stapler that indicates how many staples are left within the stapler when being operated. See *Wang* at col. 1, lines 11-30. However, the manual stapler of *Wang* fails to teach or suggest at least the above features of claims 1 and 3.

The Office Action states that *Wang* discloses "a guide member (123) for supporting a side of the base portion of the staple leg from an inner side of the stapler during the process that the staple legs penetrate the sheets." Please note the term "stapler" above is not the recited claim term. Contrary to the Office Action's assertion, *Wang* discloses a spring plate (12) with a protection plate (123) that operates so that "the staple will be pushed out by the pressing plate 111 and guided by the protection plate 123." See *Wang* at col. 3, lines 1-9. *Wang* does not disclose "a guide member with substantially parallel lateral sides for supporting an inner surface of the base portion of the staple legs," as recited in newly amended claims 1 and 3. That is, the

protection plate (123) of *Wang* does not support the inner surface of a base portion of the staple legs.

Further, assuming for the moment the protection plate (123) is the “guide member” as asserted, *Wang* does not disclose that the protection plate has “substantially parallel lateral sides” that support “an inner surface of the base portion of the staple legs.” In fact, as seen in Figs. 5A and 5B, the protecting plate 123 (lateral sides or otherwise) does not even touch an inner surface of the base portion of the staple legs. Because *Wang* does not disclose these features, it cannot anticipate the invention recited in claims 1 and 3.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejections under 35 U.S.C. § 102(b) should be withdrawn because *Wang* does not teach or suggest each feature of independent claims 1 and 3.

Additionally, Applicants respectfully submit that dependent claims 2 and 5 are also allowable insofar as they recite the patentable combinations of features recited in claims 1 and 3, as well as reciting additional features that further distinguish over the applied prior art.

All Subject Matter Complies with 35 U.S.C. § 102(b)

Claims 1 and 3-4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Heaton*. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that *Heaton* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that newly amended independent claims 1 and 3 recite the features of "a guide member with substantially parallel lateral sides for supporting an inner surface of the base portion of the staple legs during a process that the staple legs of the staple are penetrating the sheets." At least these features are not disclosed or taught by *Heaton*.

Heaton discloses a surgical stapler for applying a plurality of surgical staples to body tissue. See *Heaton* at col. 1, lines 5-8. However, the stapler of *Heaton* fails to teach or suggest at least the above features of claims 1 and 3.

The Office Action states that *Heaton* discloses "a guide member (slot wall seen in Fig. 6b, not numbered) for supporting a side of a base portion of the staple leg from an inner side of the stapler." Please note the term "stapler" is not the recited claim term. Contrary to this assertion, *Heaton* discloses slots (Fig. 6b, not numbered) in cartridge 22 from which staples 24 are ejected. See *Heaton* at col. 5, lines 19-30. *Heaton* does not disclose a guide member with substantially parallel lateral sides that support an inner surface of the base portion of the staple legs. The slots identified as cartridge 22 of *Heaton* do not support the inner surface of the base portion of the staple legs with substantially parallel lateral sides as required by claims 1 and 3. The walls of the slots support an outer surface of the staple legs, but not an inner surface of the base portion of the staple legs. Because *Heaton* does not disclose these features, it cannot anticipate the invention recited in newly amended claims 1 and 3.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Heaton* does not teach or suggest each feature of independent claims 1 and 3.

Additionally, Applicants respectfully submit that dependent claim 4 is also allowable insofar as it recites the patentable combinations of features recited in claim 3, as well as reciting additional features that further distinguish over the applied prior art.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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